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09/991,379

11/15/2001

John Joseph Mascavage III

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07/03/2006

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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/991,379

Applicant(s)

MASCAVAGE ET AL.

Examiner

Siegfried E. Chencinski

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/18/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on May 25, 2006 has been entered.

### ***Priority***

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 112 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application) in order to obtain the benefits of the filing dates of previously filed applications; the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Applicant has claimed the filing date benefit of US patent Application No. 09/516,209 filed on February 29, 2000 as a continuation-in-part thereof. However, at least one limitation in independent claims 1, 10 and 17, "automatically opening a new web browser window for the customer", does not appear to be in the claimed parent application's disclosure. Thus, at least for this limitation and any other claimed limitations not found in the claimed parent limitation, the earliest effective filing date will be the filing date of the instant application, i.e. November 15, 2001.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 1-7, 9-15 & 17-20 are rejected** under 35 U.S.C. 103(a) as being disclosed by Wilf et al (US Patent 5,899,980, hereafter Wilf), Stein et al. (US Patent 5,826,241, assigned to PayPal, hereafter Stein), Fung et al. (US PreGrant Publication 2002/0055909) and Applicant Admitted Prior Art (hereafter AAPA).

**Re. Claims 1, 10 & 17,** Wilf discloses a method for authorizing and checking out from an online purchase between a customer and a vendor site/merchant system, the method comprising steps of:

- receiving transaction information from the vendor site (Col. 2, ll. 3-15; 26-51);
- presenting a transaction amount in the new web browser window, whereby the customer can assent to the transaction amount through interaction with the new web browser window (The term “transaction detail” is an integral component of Wilf’s preferred term “transaction data” for approval by the customer/user. He uses this term throughout the reference. Examples are Col. 2, lines 30, 35, 37 and following throughout the reference. Wilf provides specific definition to the effect that a “transaction amount” is a component of this “transaction detail” as illustrated in the following locations: Col. 1, lines 27-28 and Col. 9, lines 24-29). Further, Stein discloses the presenting of the transfer amount through an internet interface (Col. 7, l. 58 – Col. 8, l. 18). The ordinary practitioner of the art would have seen it as obvious at the time of Applicant’s invention that a web browser window was a practical and popular interface for displaying this transaction data for the customer buyer’s authorization or rejection of the payment by transfer.
- receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and notifying the vendor site of authorization (Col. 2, lines 3-15, 52 – Col. 3, line 12).

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Wilf does not explicitly disclose opening a new web browser window for the customer, wherein opening the new web browser window requires no customer input. However, substituting the word "automatically" with the phrase "wherein opening the new web browser window requires no customer input" does not materially change this limitation as "opening the new web browser window requires no customer input" has the same functional meaning as the word "automatically" in the context of this limitation and the claim as a whole. The phrase accomplishes the same result as the single word "automatically" had accomplished. Therefore the practical effect for the customer user is that the web browser window opens automatically. Also, pop-up windows are one kind of automatically opening web browser window. Appellant admits in his argument that "the term "pop-up window" is notoriously well known" at the time of this parent application's filing date (Appeal Brief, page 4, l. 19; p. 8, l. 6). Further, applicant admits in his Reply Brief received on July 27, 2005 that "pop-up window is synonymous with a new web browser window, automatically opened and viewable by the customer" (p. 4, ll. 1-3). This argument is convincing as it records Applicant's admission of the "automatically opening a new web browser window for the customer" as Appellant admitted prior art (AAPA), since pop-up windows were an obvious and even ubiquitous automatic phenomenon experienced by millions of web browser users at the time of Applicant's invention. However, this admission does not invalidate the Fung reference for two reasons. First, the Fung reference discloses this feature. Second, this feature is not contained in Applicant's parent application. This limitation in Applicant's claimed invention therefore only can claim an effective filing date of November 15, 2001, since Fung's effective filing date is March 1, 2000, thus making Fung prior art. Hence, it would have been obvious to an ordinary practitioner of the art at the time of Appellant's invention to have combined the disclosure of Wilf, Stein, Fung and AAPA with well known art to establish an automated purchasing method which includes efficient automated web based steps and user conveniences for validating the payment for an online transaction without exposing the customer's personal information by maintaining security, motivated by a desire to overcome the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).

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**Re. Claims 2 & 18,** Wilf discloses the method for authorizing the online purchase between the customer and the vendor site wherein the new web browser window points away from the vendor site (Col. 2, lines 26-34).

**Re. Claims 3 & 11,** Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site further comprising a step of receiving account information from the customer corresponding to an account authorized for the debit (Col. 2, lines 34-47).

**Re. Claims 4 & 12,** Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the new web browser window overlays an existing web browser window of the vendor site (Col. 2, lines 3-5, 47-51).

**Re. Claims 5, 13 & 19,** Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the receiving transaction information step triggers the automatically opening step (Col. 2, lines 3-15).

**Re. Claims 6, 14 & 20,** Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site further comprising a step of transferring payment to an account associated with the vendor site after authorization is received (Col. 7, lines 45-57).

**Re. Claims 7 & 15,** Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site further comprising a step of presenting a message to the customer in the new web browser window indicating at least one of the following: that authorization was canceled by the customer; that authorization was rejected by a funds transfer system; and that authorization completed normally (Col. 7, line 58 - Col. 9, line 20).

**Re. Claim 9,** Wilf discloses a computer-readable medium having computer-executable instructions for performing the computer-implementable method for authorizing and checking out from an online purchase between the customer and the vendor site of claim 1 (Col. 1, line 63- Col. 2, line 3).

3. **Claims 8 & 16 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Wilf, Stein, Fung and AAPA in view of Kolling et al (US Patent 5,920,847, hereafter Kolling).

**Re. Claims 8 & 16**, none of Wilf, Stein, Fung or AAPA explicitly disclose a method for authorizing and checking out from an online purchase between the customer and the vendor, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period. However, Kolling discloses a method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period (Col. 37, lines 2-8). It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosure of Wilf with the disclosure of Kolling to establish an automated purchasing method which included a time limit for notifying a vendor of payment approval for an automated transaction in order to protect a vendor from undue delay in verifying such a transaction while minimizing costs, maintaining certain controls and discretionary actions on behalf of the biller, and simplifying the process for all the parties (Kolling, Col. 10, ll. 25-62).

#### ***Response to Arguments***

4. Applicant's arguments filed May 25, 2006 with respect to claims 1, 10 and 17 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Souh, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks, Washington D.C. 20231*


or (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

June 21, 2006

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
AK 3628